



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/589,217	06/07/2000	David Cooper	13665	8681
23389 7590 10/27/2009 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
PHAN, HUY Q				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
10/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

09/589,217

**Applicant(s)**

COOPER, DAVID

**Examiner**

HUY PHAN

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28, 29, 32 and 33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28, 29, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/21/2009 has been entered.

### ***Response to Amendment***

2. This Office Action is in response to Amendment filed on date: 09/21/2009. Claims 28, 29, 32 and 33 are still pending.  
Claim 1-27, 30 and 31 have been cancelled.

### ***Response to Arguments***

3. Applicant's arguments with respect to the amended limitations of the independent claims (see REMARKS page 5) have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 28, 29, 32 and 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30, 31, 37 and 38 of co-pending Application No. 11/410,327 respectively. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims cover the same subject matter.

Both independent claims' features of the instant application and the co-pending application can be compared as:

Claim 37 of Co-pending Application	Claim 28 of Instant Application
Claim 37. A method for user equipment handover between mobile communication networks comprising:	Claim 28. A method for user equipment for a mobile communication system comprising:
receiving a first message at the user equipment, said first message including a first list of a plurality of network identifiers available for a potential	receiving a message on said user equipment including a first list including a plurality of network identifiers available for a potential handover, said

handover, said receiving from the mobile communication network while a call is in progress;	receiving from a communication network while a call is in progress; and
comparing the first list with a second list which includes at least a network identifier and is stored in the user equipment;	comparing the received first list with a second list stored in the user equipment,
wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said first message, occurs without said user equipment searching said mobile communication network.	wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network.

However the claim 37 of co-pending application does not claim the claimed limitation of the instant application "the at least one network identifier in the second list being an identifier of a network that is never to be used". However, Daly (US 6,122,503) teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of claim 37 as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that

a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15)

Claims 29, 32 and 33 of the instant application and claims 30, 31 and 38 of the co-pending application can be compared as same as above.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

I) Claims 28, 29 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618; previously cited) in view of Sturniolo (US 6,201,962) and further in view of Daly (US 6,122,503; previously cited).

Regarding claim 28, Lynch discloses a method for user equipment (fig. 1, 12) for a mobile communication system (fig. 1, 10) comprising:

receiving a message on said user equipment including a first list of a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-8) that are available for a potential handover ("hand-off", col. 12, lines 1-5), said receiving from the communication

network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

comparing ("compared", col. 12, lines 1-5) the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list stored in the equipment ("stored"; col. 12, lines 1-5), said second list including at least one network identifier ("received SIDs"; col. 12, lines 1-5).

But, Lynch does not particularly show wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network. However in analogous art, Sturniolo teaches wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover (col. 6, lines 53-56), and said receiving of said message occurs without said user equipment searching said mobile communication network (col. 6, lines 39-56); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lynch as taught by Sturniolo for purpose of providing an alternative technique in obtaining the network identifier. Since, the user equipment can scan or request (registering) to receive the available network identifier for the potential handoff, the quality of wireless communication service will be more reliable.

But, Lynch and Sturniolo do not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list

being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lynch and Sturniolo as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 29, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

means for receiving a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-5) of a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

means for comparing ("compared", col. 12, lines 1-5) the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list which includes at least one network identifier ("received SIDs"; col. 12, lines 1-5) and is stored in the user equipment ("stored"; col. 12, lines 1-5).

But, Lynch does not particularly show wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network. However in analogous art,



Sturniolo teaches wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover (col. 6, lines 53-56), and said receiving of said message occurs without said user equipment searching said mobile communication network (col. 6, lines 39-56); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lynch as taught by Sturniolo for purpose of providing an alternative technique in obtaining the network identifier. Since, the user equipment can scan or request (registering) to receive the available network identifier for the potential handoff, the quality of wireless communication service will be more reliable.

But, Lynch and Sturniolo do not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch and Sturniolo as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

Regarding claim 33, Lynch discloses user equipment (fig. 1, 12) for a mobile communication network (fig. 1, 10) comprising:

a receiver (fig. 1, 12) for receiving a message that includes a first list of a plurality of network identifiers ("stored preferred SID list"; col. 12, lines 1-5) that are available for a potential handover ("hand-off" see col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5); and

a comparator (fig. 1, 12) for comparing ("compared", col. 12, lines 1-5) the received first list with a second list ("received SIDs"; col. 12, lines 1-5) which includes at least one network identifier and is stored in the user equipment ("stored"; col. 12, lines 1-5).

But, Lynch does not particularly show wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network. However in analogous art, Sturniolo teaches wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover (col. 6, lines 53-56), and said receiving of said message occurs without said user equipment searching said mobile communication network (col. 6, lines 39-56); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lynch as taught by Sturniolo for purpose of providing an alternative technique in obtaining the network identifier. Since, the user equipment can scan or request (registering) to receive the available network identifier for the potential handoff, the quality of wireless communication service will be more reliable.

But, Lynch and Sturniolo do not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used. However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch and Sturniolo as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

II) Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lynch (US 5,761,618; previously cited), in view of Sturniolo (US 6,201,962), in view of Daly (US-6,122,503; previously cited) and further in view of Grandhi (US 6,125,280; previously cited).

Regarding claim 32, Lynch discloses a mobile communications network (fig. 1, 10) or component (fig. 1, 12) thereof including:

means for receiving by a user equipment (fig. 1, 12) a message that includes a first list ("stored preferred SID list"; col. 12, lines 1-5) of a plurality of network identifiers that are available for a potential handover ("hand-off", col. 12, lines 1-5), from the communication network (fig. 1 and col. 11, lines 53-58) while a call is in progress (col. 12, lines 1-5 and fig. 5);

means for comparing ("compared", col. 12, lines 1-5) by the user equipment the received first list ("stored preferred SID list"; col. 12, lines 1-5) with a second list which includes at least one network identifier from the plurality of network identifiers ("received SIDs"; col. 12, lines 1-5) and is internally stored in the user equipment ("stored"; col. 12, lines 1-5); and

means for receiving from user equipment communicating with the network an indication of a preferred other network (fig. 5, step 507-510 and col. 11, lines 7-20).

But, Lynch does not particularly show wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network. However in analogous art, Sturniolo teaches wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover (col. 6, lines 53-56), and said receiving of said message occurs without said user equipment searching said mobile communication network (col. 6, lines 39-56); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Lynch as taught by Sturniolo for purpose of providing an alternative technique in obtaining the network identifier. Since, the user equipment can scan or request (registering) to receive the available network identifier for the potential handoff, the quality of wireless communication service will be more reliable.

But, Lynch and Sturniolo do not particularly show the at least one network identifier in the second list being an identifier of a network that is never to be used.

However in analogous art, Daly teaches the at least one network identifier in the list being an identifier of a network that is never to be used ("forbidden" see col. 8, lines 15-27); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the user equipment of Lynch and Sturniolo as taught by Daly in order to "control the intelligent roaming function" of the user equipment since the intelligent roaming is "a process that a mobile station or phone goes through to assure that it is receiving the best service possible regardless of the location that the phone is in" (see col. 1, lines 20-25 and col. 8, lines 13-15).

But, Lynch, Sturniolo and Daly do not particularly show means for supplying to the user equipment neighboring cell information for the preferred other network based on the indication. However in analogous art, Grandhi teaches means for supplying neighboring cell information for the preferred other network based on the indication ("provides automatic identification of neighbor cells, and configuration of neighbor cell information"; see col. 3, lines 19-23); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the network of Lynch, Sturniolo and Daly as taught by Grandhi in order to improve the handoff process in the wireless communication system, since Grandhi specifically discloses that "Handoff processes use neighbor information to help decide the most appropriate sector or cell to serve a call" (col. 1, lines 53-58).

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a) Connolly discloses that "When the portable handset terminal requests a registration it sends a location request message along with the portable handset terminal's identity. The intelligent base station formats a non-call message with the location request and portable handset terminal telephone number and PCS provider ID to be sent to the PCS Switching Center" (see specification).

b) Vaara discloses that "It is characteristic to the mobile station, according to the invention, that it includes the equipment for storing the special cell list, said special cell list including the identifier for at least one cell that offers special service to the mobile station, and the equipment for transmitting the special cell list to the mobile communication network" (see specification).

c) Emery claims "means for sending an identification of said at least one switched network means responsive to a registration of a mobile wireless station with a radio cell base station" (see specification).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUY Q. PHAN whose telephone number is 571-272-7924. The examiner can normally be reached on 9AM-7:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Huy Q Phan/  
Primary Examiner, Art Unit 2617  
Date : 10/24/09